The opinion in support of the remand being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL A. ADDINGTON, W. ROBERT ADDINGTON
and W. ROBERT ADDINGTON II

Appeal No. 2001-1382
Application No. 09/396,530

HEARD: NOVEMBER 29, 2001

Before McQUADE, NASE and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Randall A. Addington et al. have appealed from the final rejection dated August 15, 2000 (Paper No. 6). As the result of a number of irregularities which must be resolved before the merits of the appeal can be duly evaluated, the application is remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 to deal with these matters.

The following papers of interest, listed in sequence and discussed in turn, have been made of record subsequent to the final rejection:

a) the appellants' main brief (Paper No. 8);

b) the examiner's answer (Paper No. 9);

c) the appellants' reply brief (Paper No. 11);

d) the examiner's substitute answer (Paper No. 12);

e) the appellants' supplemental reply brief (Paper No. 13); and

f) the examiner's acknowledgment of the supplemental reply brief (Paper No. 14).

In the final rejection, the examiner rejects claims 14 through 30 under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 102(b), but does not treat, or even acknowledge the presence of, claims 3 and 4 which were and are still pending in the application.

The appellants' main brief notes the examiner's failure to treat claims 3 and 4 in the final rejection.[1]

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[1] The main brief (see, for example, pages 35, 38 and 39) improperly incorporates by reference arguments made in the amendment filed May 19, 2000 (Paper No. 5). 37 CFR § 1.192(a) states that the brief "must set forth the authorities and arguments on which appellant will rely to maintain the appeal," and that "[a]ny arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown."

The examiner's answer essentially constitutes a restatement of the final rejection. As such, it fails to account for claims 3 and 4 despite the notice provided in the main brief, and lacks any reasonably specific response to the various arguments advanced in the brief.

The appellants' reply brief again notes the examiner's failure to treat claims 3 and 4.

The substitute answer, which purportedly "takes the place of the previous mailed Examiner's Answer . . . which contained only a partial draft in error" (substitute answer, page 2), is far more expansive than the original answer. Among other things, it adds claims 3 and 4 to the 35 U.S.C. § 102(b) rejection, thereby rejecting these claims on a new ground, and sets forth positions in response to the arguments presented in the main and reply briefs.

The supplemental reply brief objects to "the entry or consideration of Examiner's Substitute Answer as unlawful and a violation of the Rule of Practice 37 CFR 1.193" (page 2).

The examiner's acknowledgment of the supplemental reply brief states that "Appellants[']' demand to reopen prosecution is not well taken. The Examiner's Answer mailed 2/26/01 is a 'substitute' for the Answer mailed 01/03/01 which was an incomplete draft mailed in error" (Paper No. 14, page 2).

This record poses a number of procedural problems. The failure of the final rejection to treat claims 3 and 4 contravenes 37 CFR § 1.104(b) which requires that an examiner's action "will be complete as to all matters," and the lack in the first answer of any meaningful response to the appellants' main brief runs counter to the practice set forth in MPEP § 1208. The apparent attempt to cure these deficiencies via the so-called "substitute" answer is ill founded. Even if the first answer was an incomplete draft mailed in error as asserted by the examiner, the substitute answer clearly violates the provisions of 37 CFR § 1.193 requiring that "[a]n examiner's answer must not include a new ground of rejection" and that an examiner "must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief."

On a more substantive level, the explanations of the 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 102(b) rejections in the final rejection and first answer are so ambiguous that they have precluded a complete and thorough development of the issues to be considered on appeal. The 35 U.S.C. § 112, first paragraph, rejection rests on a broadly alleged failure of the specification to discuss the method steps set forth in claims 14 through 30. While ultimately conceding that not all of the recited method steps lack such support (see page 14 in the

substitute answer), the examiner only advances the "first force" and "second force" recitations in the claims as examples of limitations which lack support and thus constitute, according to the examiner, "new matter." The examiner rationalizes this treatment on the basis that "specifically listing all instances in the claims that supported a new matter rejection would be time consuming and burdensome" (substitute answer, page 15). Be this as it may, however, basic due process considerations compel the examiner to identify each limitation in the claims which is believed to lack support in the specification. Similarly, the final rejection and first answer do not specifically point out how each and every element of the claims rejected under 35 U.S.C. § 102(b) are met by the applied reference (U.S. Patent No. 3,046,561 to Marinese et al.). While the substitute answer more fully explains the examiner's position as to each of the foregoing rejections, it cannot serve to mitigate the deficiencies of the final rejection and first answer due to its improper entry into the record.

On remand, the examiner is directed to take appropriate action, in accordance with the relevant statutes, regulations and Office practices, to resolve the foregoing problems.

REMANDED

JOHN P. McQUADE)
Administrative Patent Judge)
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JEFFREY V. NASE) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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JENNIFER D. BAHR)
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JPM/gjh

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